

Atty. Dkt. No. 025782-0114 (3669.Palm)
(f/k/a 035451-0140)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 2, 24, 37, 47, 55, and 72 are requested to be cancelled without prejudice.

Claims 1, 3-6, 12, 19, 23, 25, 26, 27, 30, 33, 35, 39, 42, 44, 46, 49, 51, 53, 59, 64, 65, 67, 68, 73, 74, 75, 82, 88, 91, and 96 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 3-23, 25-36, 38-46, 48-54, 56-71, and 73-96 are now pending in this application.

Claim Objections

In Section 1 of the Office Action the Examiner objected to Claims 12, 19, 26, 30, 33, 39, 42, 44, 49, 51, 59, 64, 65, 68, 82, 88, and 96 because of informalities in using proper Markush language. Applicants have amended the objected to claims and accordingly request withdrawal of the claim objections.

Claims Rejections – 35 USC § 102

In Section 4 of the Office Action the Examiner rejected claims 1, 7, 9-12, 16-18, 23, 28, 30-31, 33, 35, 36, 42, 44, 46, 51, 53-54, 58-59, 67-71, and 80 under 35 USC § 102(e) as being anticipated by Lincke et al., (U.S. Patent Application Publication 2002/0109706). Applicants respectfully submit that independent claims 1, 23, 35, 46, 53, and 67 have been amended and thus the claim rejection under 35 USC § 102(e) are no longer applicable as detailed below.

Atty. Dkt. No. 025782-0114 (3669.Palm)
(f/k/a 035451-0140)

Claims Rejections – 35 USC § 103

In Section 6 of the Office Action the Examiner rejected claims 2-3, 13-15, 24-25, 29, 37-38, 47-48, 55-56, 72, 81-82, 86-89, and 93 under 35 USC § 103(a) as being unpatentable over Lincke et al. as applied to claims 1, 23, 35, 46, 53, and 67 and further in view of Hsing Mei, Fu Jen Catholic University, Taiwan (hereinafter Hsing). Applicants respectfully submit that the limitation of claim 2 has been incorporated into independent claim 1. Applicants also submit that the claim limitation of claim 24 has been incorporated into independent claim 23. Applicants further submit that the limitation of claim 37 have been incorporated into independent claim 35. Further, applicants submit that the limitations of claim 47 have been incorporated into independent claim 46. Further still, applicants submit that the limitation of claim 55 has been incorporated into independent claim 53. Yet further still, applicants submit that the limitation of claim 72 has been incorporated into independent claim 67. In rejecting the claims under 35 USC § 103(a) as being unpatentable over Lincke et al. in view of Hsing, applicants assert that the Lincke et al. reference may not be used to preclude patentability in accordance with 35 USC § 103(c).

The present application and U.S. Application 09/182,945 to Lincke et al. were, at the time the invention of the present application was made, owned by Palm, Inc. or subject to an obligation of assignment to Palm, Inc. The revised 35 USC § 103(c) “applies to all utility, design, and plant patent applications filed on or after November 29, 1999.” MPEP § 706.02 (I) (1). The Lincke et al. application was assigned to Palm, Inc. and the present application was assigned to Palm, Inc. at the time of the invention, accordingly, the two references were commonly owned at the time of the invention. See MPEP § 706.02 (I) (2). Because the Lincke et al. reference may not be used to preclude patentability of the present application under 35 USC § 103(a), applicants respectfully request that the Examiner withdraw the rejection of the above-referenced claims which were based on the application of the Lincke et al. reference in view of Hsing.

Atty. Dkt. No. 025782-0114 (3669.Palm)
(f/k/a 035451-0140)

Further, in Section 7 of the Office Action the Examiner rejected claims 4-6, 19, 26-27, 39-41, 49-50, 61-65, 73-75, 83-84, and 90-92 under 35 USC § 103(a) as being unpatentable over Lincke et al. and Hsing as applied to claims 1-2, 23-24, 35, 37, 46, 67, 72, 81, 86, and 89 further in view of RealPlayer 8 Pus User Manual, RealSystem, Inc. (hereinafter RealPlayer). Applicants respectfully submit that as explained above, the Lincke et al. reference may not be used to reject the above-referenced claims under 35 USC § 103(a). Accordingly, the above-referenced claims cited in Section 7 of the Office Action are therefore allowable.

In Section 8 of the Office Action the Examiner rejected claims 8, 32, 43, 57, 78-79, and 94 under 35 USC § 103(a) as being unpatentable over Lincke et al. as applied to claims 1, 7, 23, 35, 53, 67, 86, and 93 and further in view of Rich Hall, Pocket PC Magazine (hereinafter Rich). As explained above, the Lincke et al. reference may not be used to precluded patentability of the above-referenced claims under 35 USC § 103(a). Accordingly, applicants respectfully request the withdrawal of the 35 USC § 103(a) rejection with regard to the above-referenced claims.

In Section 9 of the Office Action the Examiner rejected claims 20-22, 34, 45, 52, 60, 66, and 76-77 under 35 USC § 103(a) as being unpatentable over Lincke et al. as applied to claims 1, 23, 35, 46, 53, 61, and 67 and further in view of Chris De Herrera, CEWindows.NET (hereinafter Chris). Applicants respectfully submit that as explained above, the Lincke et al. reference may not be used to precluded patentability of the claims cited in Section 9 of the Office Action. Accordingly applicants respectfully request the withdrawal of the rejection of the claims cited in Section 9 of the Office Action under 35 USC § 103(a).

In Section 10 of the Office Action the Examiner rejected claims 66, 85, and 95-96 under 35 USC § 103(a) as being unpatentable over Lincke et al., Hsing, and RealPlayer as applied to claims 1, 23, 35, 46, 53, 61, 67, 81, and 86 above and further in view of Chris. Applicants respectfully submit that as explained above, the Lincke et al. reference may not be used to precluded patentability under 35 USC § 103(a). Accordingly applicants respectfully request the

Atty. Dkt. No. 025782-0114 (3669.Palm)
(f/lc/a 035451-0140)

withdrawal of the 35 USC § 103(a) rejection with regard to the claims cited in Section 10 of the Office Action.

Applicants believe that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date January 21, 2005

By Alistair K. Chan

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5730
Facsimile: (414) 297-4900

Alistair K. Chan
Attorney for Applicants
Registration No. 44,603